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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/994,864      | 11/28/2001  | Hiroaki Sakagawa     | 500.40915X00        | 9819             |

24956 7590 09/22/2006

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EXAMINER

LAstra, DANIEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/994,864

Applicant(s)

SAKAGAWA, HIROAKI

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/28/2001</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-12 have been examined. Application 09/994,864 (ELECTRONIC MAIL ADVERTISEMENT SYSTEM, METHOD, AND PROGRAM STORAGE MEDIUM) has a filing date 11/28/2001 and foreign priority 12/01/2000.

#### ***Claim Objections***

2. Claim 10 is objected to because of the following informalities: Claim 10 recites in page 52 "user informations" where it should recites "user information". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 recites the limitation "about the user ID". There is insufficient antecedent basis for this limitation in the claim.

Claim 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 6 recites "the server sends an information about an advertisement to the electronic mail". Said limitation is indefinite because advertisement information is sent to a terminal but not to an electronic mail. Claim 2 recites "wherein the identifier added to the URL is an information about the terminal that recognizes the identifier". Said limitation is indefinite because it is saying that an identifier recognizes an identifier. Claim 3 recites "by specifying the displayed information". Said limitation is indefinite does not clear teach the meaning of specifying.

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For purpose of art rejection, said limitation would be interpreted as meaning selecting an advertisement. Claim 4 recites "wherein the server which received the advertisement-related URL and the identifier from the terminal accesses another terminal according to the URL, and identifies the terminal that sent the advertisement-related URL based on the identifier". Said limitation is indefinite because it seems to say that the server accesses another terminal but then the terminal is the one accessing the server. Claim 1 recites "a unit for accepting a request to send an electronic mail from the terminal". Said limitation is indefinite because it is not clear if the electronic mail is sent from the terminal to the server or from the server to the terminal. Claim 7 recites "inquiring to the mail server by the server whether the mail server has received any electronic mail addressed to the user terminal". Said limitation is indefinite because it is not clear the meaning of electronic addressed to the user terminal. Claim 7 recites "adjecting an indentifier to a URL for referring to the advertisement information". Said limitation is indefinite because the it does not explain the meaning of adjecting an indenfier. Claim 12 recites "the server extracts a creator of the electronic mail, matches it with the user and holds them". Said limitation is indefinite because it does not teach what is hold and the meaning of a creator of the electronic mail. For purpose of art rejection, said limitation would be interpreted as not paying a user if said user is not displaying or viewing advertisements.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Jacobs (US 2004/0039784).

As per claims 1-7, Jacobs teaches:

An advertisement method using an electronic mail in a system in which a user terminal, a server, a database, a mail server and an advertiser terminal are connected to a network, wherein the advertisement method using an electronic mail comprising the steps of:

holding in the database an user-related information sent from the user terminal and an advertisement-related information sent from the advertiser terminal (see paragraphs 28, 131, 173);

accepting an electronic mail receive request data sent from the user terminal by the server and extracting a user identifier from the receive request data (see paragraph 173 "cookie");

based on the electronic mail receive request, inquiring to the mail server by the server whether the mail server has received any electronic mail addressed to the user terminal, if the inquiry finds that there is an electronic mail addressed to the user terminal, receiving the electronic mail by the server (see paragraphs 193-195; 203-209);

based on the extracted user identifier, searching through the user-related information and the advertisement-related information stored in the database (see paragraphs 193-195; 203-209);

based on a result of the search, inserting an advertisement and information into the electronic mail received by the server, adjecting an identifier to a URL for referring to the advertisement information and sending the electronic mail attached with the advertisement information to the user terminal (see paragraphs 22-24; 108-109).

As per claims 8 and 9, Jacobs teaches:

An advertisement method using an electronic mail of claim 7, wherein in the step of inserting the advertisement into the electronic mail being received by the user terminal, the server calculates an amount of money to be refunded to the user according to a location where the advertisement is inserted, and sends a result of the calculation to the advertiser terminal (see paragraphs 126-127).

As per claim 10, Jacobs teaches:

In a system having a user terminal for sending and receiving an electronic mail, an advertiser terminal for providing an advertisement, and a server for forwarding an electronic mail to the user terminal at the request of the user terminal, an advertisement method using an electronic mail for sending by the server an electronic mail and advertisement-related information to the user terminal, wherein the server holds an amount of money to be refunded which is provided in advance by an advertiser, when receiving from the user terminal an information for identifying the advertiser terminal (see paragraphs 20-24; 129) and an identification information for identifying the user,

the server identifies the user corresponding to the identification information by user information matched to the identification information in advance and allocates to the user a part of the amount of money to be refunded (see paragraphs 126-127).

As per claim 11, Jacobs teaches:

An advertisement method using an electronic mail of claim 10, wherein the server accesses the advertiser terminal based on the advertiser terminal identification information and sends the advertisement provided by the advertiser terminal to the user terminal to which a part of the amount of money to be refunded was able to be allocated (see paragraph 173).

As per claim 12, Jacobs teaches:

An advertisement method using an electronic mail of claim 11, wherein, in the process of sending an electronic mail to the user terminal, the server extracts a creator of the electronic mail, matches it with the user and holds them, and after receiving from the user terminal information for identifying the advertiser terminal and identification information for identifying the user, the server does not allocate to the user a part of the amount of money to be refunded when the creator of the electronic mail and the user are identical (see paragraphs 126-127).

### ***Conclusion***

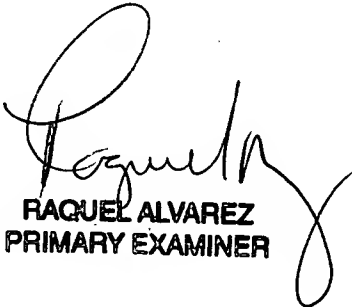
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra  
September 12, 2006

  
RAQUEL ALVAREZ  
PRIMARY EXAMINER